

U.S.S.N. 10/765,223

Smith et al.

Response to Office Action and Request for Reconsideration

REMARKS

Claims 28-41 are pending in this application. Claims 1-27 were canceled as a result of a Restriction Requirement. Claims 28 and 29 are withdrawn from consideration, and Claims 30-41 have been rejected.

By this paper Claim 30 has been amended. This amendment contains no new matter and is fully supported in the specification, see for example, paragraph [0111] and the provisional applications incorporated in the present application.

Rejection of Claims Under 35 U.S.C. § 103

Claims 30-41

In paragraphs 3 and 4 of the pending Office Action, the Examiner rejected Claims 30-41 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Number 6,737,207 to Imai. Applicant respectfully traverses this rejection.

The Law of Obviousness

In order to establish a *prima facie* case of obviousness, three basic criteria must be met:

"First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined), must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure." M.P.E.P. § 2142. (emphasis added)

I. No motivation to modify the reference

M.P.E.P. § 2143.01 states: "if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being

modified, then the teaching of the references are not sufficient to render the claims *prima facie* obvious."

The Examiner states in part "However, the particular step of subtracting the offset values associated with the wafer is not discussed. . . . Although the prior art is silent with respect to these particular limitations, one of ordinary skill in the art would have found the invention *prima facie* obvious in view of the Imai patent since the teachings specifically say that the system can be evaluated independently." The Applicant respectfully disagrees. There is no teaching or suggestion in Imai of a method that would allow independent evaluation. Additionally, the Examiner has provided no reference to support his assertion that it would be well known in the art to use the self-referencing method taught by the Applicant. If the Examiner maintains this rejection, Applicant respectfully requests the Examiner provide a specific reference providing motivation to modify the teachings of Imai to include wafer self-referencing techniques. It is respectfully submitted that there is no motivation to modify the Imai reference and as such a *prima facie* case of obviousness has not been established. M.P.E.P § 2144.03

The rejection of independent claim 30 is traversed on this basis. Since dependent claims 31-41 depend from and further define and limit the invention described in independent claim 30, it is respectfully submitted that the rejection to these dependent claims has been traversed by virtue of their dependency from independent claim 30. M.P.E.P § 2143.03 The Applicant respectfully requests the Examiner reconsider and withdraw this rejection.

II. The proposed modification does not teach or suggest claim elements.

As explained above, the Office Action makes a Section 103 rejection by modifying the Imai reference. Because a modification to the prior art is required to support this 35 U.S.C. section 103 rejection, an appropriate motivation to modify must be set forth in order to establish a *prima facie* case of obviousness. See, *In re Fritch*, 972 F.2d 1266 (Fed. Cir. 1992).

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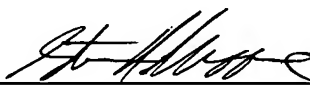
Even if the Imai reference were modified, albeit improperly, it would still not teach all of the elements as recited in Applicant's amended independent claim 30. Specifically, the Imai reference fails to teach, imply, or suggest either explicitly or inherently the claim element "self-referencing the reference wafer by subtracting offset values, associated with the wafer, from the measurements". Since any modification of the Imai reference would be absent of this important claim limitation, the rejection is traversed. Since dependent claims 31-41 depend from and further define and limit the invention described in independent claim 30, it is respectfully submitted that the rejection to these dependent claims has been traversed by virtue of their dependency from independent claim 30. M.P.E.P § 2143.03 The Applicant respectfully requests the Examiner reconsider and withdraw this rejection.

Conclusion

Applicant believes that this Response has addressed all items in the Office Action and now places the application in condition for allowance. Accordingly, favorable reconsideration and allowance of claims 30-41 at an early date is solicited.

Should any issues remain unresolved, the Examiner is invited to telephone the undersigned.

Respectfully submitted,
HELLER EHRMAN LLP

By: 
Steven A. Moore
Registration No. 55,462

Attorney Docket No. 38203-6081B

Address all correspondence to:

Steven A. Moore

HELLER EHRMAN LLP

4350 La Jolla Village Drive, 7th Floor

San Diego, CA 92122-1246

Telephone: (858) 450-8400

Facsimile: (858) 450-8499

Email: steve.moore@hellerehrman.com

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